

Serial No: 10/647,313  
Art Unit: 1616  
Response to Office Action mailed 07/19/2006

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Remarks and Arguments:

Claims 1, 5, 7, 9, 10, 11 and 15 have been amended. Claim 17 has been added as supported by the specification as filed. Accordingly, claims 1-17 remain for consideration in this application. The above amendments and the following remarks are submitted as a full and complete response to the Office Action of 07/13/2006.

Claims 1-16 have been rejected under 35 U.S.C. § 112, second paragraph. In response, occurrences of "sheet-like" have been amended to read --sheeted--.

The Examiner has rejected claims 1 to 16 under 35 U.S.C. § 103(a) as being unpatentable over of U.S. Patent 5,972,360 (Braun) in view of U.S. Patent 6,153,208 (McAtee et al.) and further in view of both U. S. Patent 6,630,163 (Murad) and U. S. Patent 5,514,367 (Letini et al.) . Applicant respectfully traverses this rejection.

With respect to independent claim 1, the Examiner is arguing that McAtee et al. and Murad each provide a self-tanning composition using a green tea extract as a tanning agent.

The present invention relates to a self-tanning composition comprising 45% to 65% by weight of aqueous extract of Japanese green tea, 5% to 15% by weight of dihydroxyacetone, 5% to 25% by weight of ethoxydiglycol and 3% to 10% by weight of PPG-12-Buteth-16 as an emollient.

There are many types of green tea available and many of these varieties are used in the cosmetic products. However, the inventor of the present invention has specifically chosen to use aqueous extract of Japanese green tea for its numerous benefits. The present inventor discovered the surprising advantage of the use of an aqueous extract of Japanese green tea to increase "the activity of the other ingredients which are found in the self-tanning composition formulation" (paragraph [0093] of the present application). This synergistic effect discovered by the inventor is one reason that Japanese green tea is used by the present inventor. Also green tea from Japan has a high concentration of catechins that are potent antioxidants and provide bacteriostatic action. In contrast, green tea from India or Peru, for example, possesses different properties. No other green tea contains the same amount of catechins as does Japanese green tea. Additional benefits of Japanese green tea are disclosed in paragraph [0093] of the present specification.

The advantages of using Japanese green tea as discovered by the present inventor is not disclosed, taught or even appreciated by the prior art.

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In the current office action, the Examiner has agreed that McAtee et al. teaches the use of green tea as a skin lightening agent, but the Examiner has argued that when a composition is found in the prior art, statements of intended use are not of patentable distinction. However, the present claims are specifically directed to a self-tanning composition having aqueous extract of Japanese green tea. Therefore the composition of a self-tanning composition having aqueous extract of Japanese green tea extract as defined by present independent claim 1 is not found in the prior art.

With respect to the teachings of Murad, in column 2, lines 38 to 46, Murad discusses a prior art self tanner formulation having an Environmental Protection Complex containing green tea. The purpose or intended use of the green tea in this formulation is not specifically discussed.

Again, present independent claim 1 recites the specific use of an aqueous extract of Japanese green tea. The green tea taught by Murad could be any type of green tea used for any purpose. As mentioned above, many different types of green tea are used in the cosmetics industry and the teachings of Murad do not indicate that aqueous extract of Japanese green tea is contemplated.

Applicant fails to see how either McAtee et al. or Murad can teach one ordinarily skilled in the art to arrive at the presently claimed invention when neither reference teaches the use of an aqueous extract of Japanese green tea. Neither reference even hints at the suggestion of using aqueous extract of Japanese green tea for its benefits discovered by the present inventor.

It is established law that it is impermissible to ignore the advantages, properties, utilities, and unexpected results flowing from the claimed invention; they are part of the invention as a whole. *In re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987).

The Examiner is respectfully reminded that to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2142. Applicant submits that the Examiner has not met this requirement since none of the references even hint at the suggestion of the specific use of aqueous extract of Japanese green tea be used for its beneficial properties discovered by the present inventor.

Additionally, claim 1 also specifically recites the presence of dihydroxyacetone and ethoxydiglycol, the purpose and benefits of each being disclosed in paragraphs

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[0094] and [0095] of the present application. Applicant submits that these recitations are also not taught in nor suggested by the cited references.

With respect to independent claim 11, this method claim also recites the specific use of an aqueous Japanese green tea extract and is distinguishable over the cited art for at least similar reasons as provide with respect to claim 1.

Also with respect to claim 11, the Examiner has argued that no patentable distinction can be found with respect to said process limitations. Applicant respectfully traverses this.

In method claim 11, the substrates are infused by being placed in a vacuum chamber in which they can be agitated and tumbled, and the ingredients are added in a specific order at specific temperatures. One of the specific steps recited is the step of "introducing said aqueous extract of Japanese green tea into said vacuum chamber while maintaining said temperature of step (d), and tumbling and agitating said plurality of sheeted substrates for a period of 20 to 25 minutes". The present inventor has found that this temperature (70° C. to 75° C. as recited in step (d)) is an ideal temperature at which to introduce the aqueous extract of Japanese green tea; a cooler temperature will not facilitate infusion of the aqueous extract of Japanese green tea onto the sheeted substrate, and a higher temperature is not needed and results in a waste of energy.

Applicant submits that none of the cited references teach this step of infusing aqueous extract of Japanese green tea onto a substrate.

Further, the method includes the step of introducing 0.05% to 0.5% by weight of cosmetically acceptable and compatible minerals into a vacuum chamber at a temperature of 48°C to 52°C. Use of such minerals generates "electrolytes during the infusion process, so as to assure infusion and capture of the various other ingredients in the matrix of the sheet-like substrate" (paragraph [0116] of the present application). This ensures that the self-tanning composition will not migrate away from the sheet-like substrate until such time as it is applied to the skin so as to transfer from the sheet-like substrate onto the skin of the user. Paragraph [00161] of the present application points out that the infusion process of the present invention results in a stable product so that streaking and blotching of the skin does not occur.

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Therefore, Applicant submits that claim 11 does set out patentably distinct process limitations over the cited art. If the Examiner disagrees, the Examiner is requested to point out where the cited art teaches the limitations of claim 11.

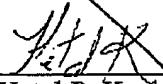
The Examiner has also raised a blanket rejection that remaining dependent claims 2 to 10 and 12 to 16 are obvious in view of the cited references. This rejection is unsubstantiated. Applicant traverses this and respectfully requests that the Examiner provide details as to how the Examiner arrived at this conclusion so that Applicant may have adequate opportunity to respond. In particular, the Examiner is asked to direct the Applicant's attention to where each recitation of each rejected dependent claim is found in the cited art.

Applicant submits that the dependent claims are distinguishable over the cited references for at least the same reasons as those given to the respective parent claims. Further, Applicant submits that the recitations of each dependent claim are not taught nor suggested by the prior art.

In a similar fashion, Applicant submits that new claim 17 is distinguishable over the cited art.

Accordingly, Applicant respectfully requests a timely Notice of Allowance be issued in this case.

Respectfully submitted,

  
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